



#20/Election
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Attorney's Docket No.: C110470016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kevin J. Dowling, et al.
Serial No.: 09/805,590
Confirm. No.: 1160
Filed: March 13, 2001
For: LIGHT-EMITTING DIODE BASED PRODUCTS

Examiner: A., Minh D.
Art Unit: 2821

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 17th day of July, 2003.


Stephanie Godino

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT/ELECTION

Sir/Madam:

In response to the Office Action mailed June 17, 2003 in the above-identified application, Applicants hereby elect the invention of Group 1, namely claims 1-50, for further prosecution.

As identified in the Office Action, claim 1 (the only independent apparatus claim) links Group 1 (claims 1-50) and Group 2 (claims 1 and 51-68). Upon the allowance of independent claim 1, the restriction requirement as to Group 2 shall be withdrawn and the claims of Group 2 will be entitled to examination in the instant application.

Applicants do not traverse the restriction requirement as to Groups 1 and 2 (Applicants also do not traverse the restriction requirement as to Groups 3 and 4). However, the election of the Group 1 claims is made with traverse to the restriction requirement as to Groups 1 and 3. Group 3 includes the only independent method claim, claim 69, and claims depending therefrom

(claims 70-89). The Applicants respectfully submit that search and examination of all of the claims pending in Groups 1 and 3 can be made without serious burden on the Examiner.

In support of the Restriction Requirement regarding Groups 1 and 3, the Office Action states that the respective inventions corresponding to these groups allegedly are related as process and apparatus for its practice. According to MPEP §806.05(e), a process and an apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process. The MPEP points out that *the burden is on the Examiner to provide reasonable examples that recite material differences* (MPEP §806.05(e); emphasis added).

In item 8 on page 4, with respect to the claims of Groups 1 and 3, the Office Action merely states summarily that “the apparatus as claimed can be used to practice another materially different process.” However, beyond this, the Office Action fails to provide any reasonable example that shows that the apparatus of independent claim 1 can be used to practice a materially different process than that claimed in independent method claim 69.

Rather, in item 9 on page 5, inasmuch as this passage can be understood, the Office Action appears to allege that an apparatus corresponding to the Group 1 claims could be *controlled* by any number of processes that are different than those recited in the steps of the Group 3 claims. Applicants respectfully submit that this line of reasoning is not relevant to the inquiry set forth in MPEP §806.05(e); the Office Action first alleges that the apparatus of Group 1 can be used to practice a materially different process than that claimed in Group 3, and then appears to say that a materially different process than that claimed in Group 3 may be used to control the apparatus of Group 1. These are different and, in fact, opposite arguments; how the apparatus *is controlled* is a different analysis than how the apparatus *functions to practice a process*. In any case, the Office Action fails to support either of these analyses with reasonable examples. Accordingly, the Examiner has not met his burden with respect to supporting the Restriction Requirement between Groups 1 and 3.

In sum, Applicants have distinctly and specifically pointed out what are respectfully believed to be errors in this Restriction Requirement, and hence traverse this requirement with

respect to Groups 1 and 3. In doing so, Applicants retain the right to petition from the requirement under 37 C.F.R. §1.144.

Applicants respectfully request the Examiner to reconsider and withdraw the Restriction Requirement between Groups 1 and 3 and proceed with prosecution on the merits of all of the pending claims in these groups.

Respectfully submitted,

Kevin J. Dowling, et al., Applicants

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Attorney Docket No.: C110470016
Date: July 16, 2003
x07/17/03x



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Stephanie Godino

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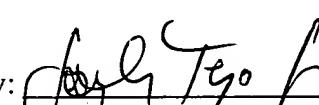
Sir:

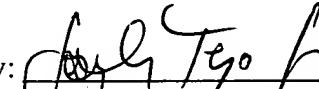
Transmitted herewith are the following documents:

Response to Restriction Requirement/Election
 Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch are respectfully requested to contact the undersigned at (617) 395-7000.

A check is not enclosed. If a fee is required, the Commissioner is hereby authorized to charge Deposit Account No. 50/2762. A duplicate of this sheet is enclosed.

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